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08/981,360	12/18/1997	Kari Kirjavainen	U 011574-0	3410

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EXAMINER

BRUENJES, CHRISTOPHER P

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 01/27/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-16

# Office Action Summary

Application No.

08/981,360

Applicant(s)

KIRJAVAINEN ET AL.

Examiner

Christopher P Bruenjes

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 15-21 is/are pending in the application.
- 4a) Of the above claim(s) 13, 16 and 17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12, 15 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Election/Restrictions***

1. Newly submitted claims 16 and 17 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 16 and 17 relate to an independent invention drawn to a cross-linked plastic sleeve, which is a different invention from the tubular product claimed in claims 1-12, 15, and 18-21.
2. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 16 and 17 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***WITHDRAWN REJECTIONS***

3. The objection to the abstract and specification of record in Paper #12, Pages 2-4 Paragraph 3 and 4 have been withdrawn due to Applicant's amendments in Paper #15.

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4. The objections to claims 6-12 of record in Paper #12, Page 4 Paragraph 5 have been withdrawn due to Applicant's amendments in Paper #15.

5. The 35 U.S.C. 112 rejections of claims 2-12 of record in Paper #12, Pages 4-8 Paragraphs 6 and 7 have been withdrawn due to Applicant's amendments in Paper #15.

6. The 35 U.S.C. 102 rejections of claims 1-5 and 11-12 as anticipated by Bast of record in Paper #12, Pages 9-10 Paragraph 9 have been withdrawn due to Applicant's amendments in Paper #15, specifically the limitation that the tie layer must be "melt processible". Note this limitation is determined to be new matter and in the event the new matter is cancelled the rejection would be restated.

**REPEATED REJECTIONS**

7. The 35 U.S.C. 102 rejections of claims 1-2, 5-9 and 11-12 as anticipated by Stanley are repeated for the reasons previously of record in Paper #12, Pages 8-9 Paragraph 8.

Regarding the new limitation that the tie layer is foamed plastic made of foamed melt processible adhesion plastic and that the tie layer and the innermost layer are extruded

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simultaneously against the base layer. The foamed layer is contiguous with the inner skin layer (see abstract); therefore it is in contact with the innermost layer. Adhesion plastic is determined to define a plastic that is able to adhere. In this case Stanley teaches that the foam is formed from a cross-linked polyethylene, which is known to be adhesive to some substrates, therefore Stanley teaches an adhesion plastic.

8. The 35 U.S.C. 103 rejection of claim 10 over Stanley in view of Donuiff et al is repeated for the reasons previously of record in Paper #12, Pages 11-13 Paragraph 10.

9. The 35 U.S.C. 103 rejections of claims 3 and 4 over Stanley in view of Bast are repeated for the reasons previously of record in Paper #12, Pages 13-14.

#### **NEW REJECTIONS**

##### ***Specification***

10. The amendment filed September 11, 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The

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added material which is not supported by the original disclosure is as follows: melt processible.

Applicant is required to cancel the new matter in the reply to this Office Action.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35

U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

11. Claims 1-12, 15, and 18-21 are rejected under 35

U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification fails to teach or suggest that the tie layer is made of foamed "melt processible" adhesion plastic. The fact that the specification teaches that the tie layer is extruded or molded does not give a basis for stating that the tie layer is melt processible or

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thermoplastic, because a thermoset resin can be extruded under the correct conditions.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

12. Claims 15 and 18-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Stanley (USPN 4,640,313).

Stanley anticipates a tubular product comprising at least three layers, a base layer, an innermost layer made of plastic, the base layer and the innermost layer having poor adhesion to each other, and a tie layer between the base layer and the innermost layer, which is a foamed material (see abstract). The tie layer has a better adhesion to the base and innermost layers than the base and innermost layers have to each other. Note the process of making the innermost layer receives little patentable weight. The tie layer contains filler such as copolymerizable ingredients, catalysts, or crosslinking agents (col.8, 1.9-30). The innermost layer is oriented by drawing both axially and

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radially (col.2, 1.31-36). The tie layer is slightly drawn but is dimensionally stabilized finally upon occurrence of such foaming expansion (col.2, 1.36-39). Regarding the new limitation to claim 1, which claims 18-20 ultimately depend, the foamed layer is contiguous with the inner skin layer (see abstract); therefore it is in contact with the innermost layer. Adhesion plastic is determined to define a plastic that is able to adhere. In this case Stanley teaches that the foam is formed from a cross-linked polyethylene, which is known to be adhesive to some substrates, therefore Stanley teaches an adhesion plastic.

***ANSWERS TO APPLICANT'S ARGUMENTS***

13. Applicant's arguments regarding the objections to the claims, specification and abstract have been considered but are moot since the rejections have been withdrawn.

14. Applicant's arguments regarding the 35 U.S.C. 112 rejections of record have been considered but are moot since the rejections have been withdrawn.

15. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 1-5 and 11-12 as anticipated by Bast have



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been considered but are moot since the rejections have been withdrawn.

16. Applicant's arguments regarding the 35 U.S.C. 102 rejections of claims 1-2, 5-9, and 11-12 as anticipated by Stanley have been considered but they are not persuasive.

In response to Applicant's argument that Stanley doesn't teach that the foamed plastic is made of foamed melt processible adhesion plastic, Stanley teaches that the tie layer is formed of cross-linked polyethylene foam, which is known to be melt processible and because the foam is cross-linked it has some adhesive properties, making it a adhesion plastic.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., strong adhesive bonding between the tie layer and the innermost or base layer are not claimed, only the fact that the tie layer has some adhesive properties) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

17. Applicant's arguments regarding the 35 U.S.C. 103 rejection of claim 10 over Stanley in view of Donuiff et al have been considered but they are not persuasive.

In response to applicant's argument that Donuiff teaches grafting polyethylene to achieve a crosslinkable material has noting to do with adhesion properties, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

#### **Conclusion**

18. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

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statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-0987.

Christopher P Bruenjes  
Examiner  
Art Unit 1772

CPB   
January 12, 2004

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

1/23/04